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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,255	11/02/2001	Irwin Kotovsky	KOT0V-11	1332

7590 04/03/2003
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EXAMINER

AMARANTIDES, JOHN

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/005,255

Applicant(s)

KOTOVSKY, IRWIN

Examiner

John Amarantides

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 19 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-3 and 5-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-3 and 5-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 02 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a)
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment to the specification, filed on 19 February 2003 has been entered.
2. Applicant's amendment to the claims, filed on 19 February 2003 has been entered. Claims 1, 5, 12 and 15 have been amended. Claim 4 has been cancelled. Claims 1 – 3 and 5 – 19 are still pending in this application, with claims 1, 12, 15, 18 and 19 being independent.
3. The Examiner agrees with the Applicant that the pre-cast plaster panel (11) and the one-piece layer (18) are two different parts and withdraws the objection with regard to the specification, but not the drawings.

Drawings

4. The drawings are objected to because in Figure 1 the one-piece layer (18) is indicated by a reference line with arrow not touching the part, and the pre-cast panel (11) uses a reference line with arrow touching the part, while in Figure 2 the opposite is shown in a different view. It is unclear as to which is the one-piece layer and the pre-cast panel. All referenced parts must be clearly identified in the drawings. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2875

6. Claims 1, 12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hutain (US006095671A).

a. In regard to claims 1, 12 and 15, Hutain teaches all the structural elements of the invention. Hutain in Figures 2A, 2D and 2E discloses a lighting assembly (206) with a trim housing (122) inside a box housing (108) and 3 lamps (174c), with a fitted one piece aperture plate (210) with apertures (212) aligned with respect to the lights. Hutain in Figure 2D discloses a seat in the housing (108), trim (holder/transition piece) ring (126) between the one-piece aperture plate (210) and the ceiling, and secured by two arms (102,104), which is a means of merging the lighting assembly into the building structure for support.

Claim Rejections - 35 USC § 103

7. Claims 2, 3, 5 – 11, 13, 14, 16, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hutain (US006095671A).

a. Hutain applies in the same manner as above. Hutain discloses multiple embodiments for configurations, lamp types, power requirements and cooling that can be interchanged to meet the intended use by the user.

Art Unit: 2875

- b. In regard to claims 2, 13 and 16, Hutain in Figure 1B discloses a trim ring (126) with a cylindrical (shield) ring wall (146) and an extender ring (124) for lamp positioning.
- c. In regard to claim 3, Hutain in Figure 1B discloses an individual lamp trim housing (122) and Figure 2D discloses a multiple lamp trim housing (122) to hold lamps.
- d. In regard to claims 5, 7, 14 and 17, nevertheless, it is old and well known that the one piece layer can be made of any suitable material and the method for securing the layer to the ceiling is depended on the selected materials. Plaster or wallboard can be taped, spackled, sanded, primed and painted to eliminate an unsightly joint, which is industry practice in residential and commercial construction.
- e. In regard to claim 6, Hutain in Figure 2A discloses mounting arms (104, 102 (not shown)) or bracket. Nevertheless, it is old and well known that the type and quantity of mounting devices would be determined be the size, weight and materials used for the lighting apparatus and the ceiling.
- f. In regard to claim 8, Hutain in Figure 2D discloses transformers (208) connected to lamps (174c) and a junction box (106) to provide electricity.
- g. In regard to claim 9, Hutain in column 14, lines 64 – 67 discloses that a gimbaled apparatus maybe affixed to the trim.
- h. In regard to claim 10, Hutain in Figure 1B, discloses a cylindrical ring wall (146) with an edge, but does not say what shape it forms. Nevertheless, it is old and well known that the edge must have a surface face and the shape would be dependent on the gumball ring swing and lamp attachment and functional movement.

Art Unit: 2875

i. In regard to claims 11 and 19, Hutain in Figure 2E discloses an asymmetrical pattern of holes (212). Nevertheless, it is old and well known that the holes (212) would either have to be cut or molded dependent on the material selected for the one-piece aperture plate (210).

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hutain (US006095671A) as applied to claim 1 above, and further in view of Merko (US005353211A).

a. In regard to claim 18, Hutain does not teach a method of forming a fixture or panel with the process tied to the material selected for the lamp assembly. Merko in the Abstract discloses that a light housing can be molded of one piece of plastic. Nevertheless, it is old and well known that light fixtures and panels can be made of metal, plastic or other materials requiring molding or cutting. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to use Merko's molding method to mold the housing and panel of Hutain's in order to enhance the fixture and panel aesthetics and minimize field construction of the lighting assembly.

Response to Arguments

9. Applicant's arguments filed 19 February 2003 have been fully considered but they are not persuasive. In regard to claims 1, 12 and 15, Hutain does provide a means for merging the light panel layer into the building structure to be supported by the building structure. The Applicant also argues that the one-piece layer is integrated smoothly into the building structure, but does not claim this in claims 1, 12 and 15. Furthermore, all lighting systems installed in

Art Unit: 2875

walls, ceilings and floors are supported by the building structure as they are attached to the structure, which is construction industry practice.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Amarantides whose telephone number is 703-305-4013. The examiner can normally be reached 8:00am-4:30pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 703-305-4939. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9318 for regular communications and 703-872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-3329.

Application/Control Number: 10/005,255

Page 7

Art Unit: 2875

JA

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March 26, 2003

John